

REMARKS/ARGUMENT

I. Prosecution History

The application as filed contained 34 claims. On March 26, 2001, the Examiner issued a five-way restriction requirement. The Applicants responded on July 26, 2001 by electing Group I, claims 1-16, 24, and 27 and SEQ ID NO: 33, with traverse, for continued prosecution.

A second office action was issued on August 8, 2001 stating that the computer readable format of the sequence listing was defective. The Applicants responded on August 21, 2001 with a substitute copy of the sequence listing in paper and computer readable formats.

On December 28, 2001, the Examiner issued an office action rejecting claim 24 and withdrawing all other claims. The Applicants filed an amendment and response on March 28, 2002 amending the sequence identification numbers in claims 16 and 24.

The Examiner next issued an office action on June 17, 2002 indicating that the previous response by the Applicants was unresponsive due to the omission of corrected drawings. The Applicants responded by submitting the corrected drawings on July 17, 2002. The Examiner then issued an office communication mailed October 15, 2002 stating that the Applicants' Amendment and Response filed on March 28, 2002 (received on April 3, 2002; Paper #9) was non-responsive to the prior office action dated December 28, 2001, because the species elected does not belong to the elected Group I. The Applicants then had a telephone interview on November 26, 2002 with Examiner S. Zhou, where it was realized that the wrong sequence (SEQ ID NO: 33) was searched by the Patent Office due to an inadvertent error in original claim 24 in the application. The Applicants responded on December 15, 2002 clarifying that the species originally intended for election was SEQ ID NO: 34, but due to the aforementioned error in the numbering of sequence identification numbers in original claim 24, SEQ ID NO: 33 was unintentionally elected and searched. Consequently, the Applicants respectfully submitted that the sequence identification numbers in claim 24 were correct as amended on March 28, 2002 and requested that a new search be

performed for SEQ ID NO: 34, which was intended in the original election. Claims 1-34 were pending.

In an Office Action dated March 6, 2003, the examiner rejected claims 1, 2, and 27 and objected to claims 7, 16, and 24 as being dependent upon a rejected base claim under 35 U.S.C. § 102(e) as anticipated by Dower et al. (U.S. Patent No. 6,251,864). Claims 1, 3-6, 8-15, 17-23, 25-26, and 28-34 were withdrawn from consideration; claims 17-23, 25-26, and 28-34 were drawn to a non-elected invention and claims 3-6 and 8-15 were drawn to a non-elected species. The Applicants overcame the rejection in a Response to the Office Action filed September 8, 2003.

The outstanding Office Action was issued on December 10, 2003. Claims 1, 2, and 27 were again rejected and claims 7, 16, and 24 were objected to under 35 U.S.C. § 102(e) as being anticipated by Dower et al. (U.S. Patent No. 5,869,451). Claims 1, 3-6, 8-15, 17-23, 25-26, and 28-34 remain withdrawn from consideration; claims 17-23, 25-26, and 28-34 are drawn to a non-elected invention; and claims 3-6 and 8-15 are drawn to a non-elected species. The Applicants reserve the right to petition this decision.

II. Amendment and Remarks

Regarding the amendment to the specification at page 7, line 8 and at page 11, line 3, to include cysteine and alanine in the definition of X9, there is support for this amendment in the sequences of SEQ ID NOS. 11, 12, and 13 at, e.g. page 19, lines 15-23. The omission of the cysteine and alanine from the definition of X9 was an obvious and correctable error because SEQ ID NOS. 11, 12, and 13 include one of these residues at position X9, and it is clear from the specification that the applicant intended to claim compounds having these polypeptide sequences. Therefore, the amendment does not include new matter.

Regarding the amendment to the specification in Table 1 at page 46, line 19, by deleting "(EC50)," the inclusion of EC50 in this table was merely a typographical error. As described on page 43, lines 13-25, and at the end of Table 1, at page 47, lines 15-19, Table 1 presents the relative potencies of the various compounds on the proliferation of murine 32D cells transfected with full-length c-Mpl. Although the EC50 of various compounds may have

been used in determining relative potencies of the compounds on cell proliferation, EC50 values are not reported in Table 1 and thus, the term is not relevant in Table 1.

The Applicants do not intend by any amendments to abandon the subject matter of any claim previously presented. The Applicants reserve the right to pursue the subject matter of such claims during prosecution of this or subsequent applications. Rejected claims have been canceled solely to accelerate issuance of allowed claims 7, 16, and 24. Claims to canceled subject matter will be pursued in related applications.

III. Patentability Argument

A. The Rejections Under 35 U.S.C. § 102 Should Be Withdrawn

On pages 2-3 of the Office Action, the Examiner rejected claims 1, 2, and 27 under 35 U.S.C. § 102(e) as being anticipated by Dower et al. (U.S. Patent No. 5,869,451, filed 12/11/96). The Examiner asserted that Dower et al. teach peptides that bind to the thrombopoietin receptor, and compositions thereof, and all of the elements of the Applicants' invention with respect to the specified claims are instantly disclosed by the teaching of the reference. The Applicants respectfully traverse.

Nonetheless, in an effort to expedite prosecution of the application, claims 1, 2, and 27 are canceled herein. Applicants respectfully submit therefore that the rejection must therefore be withdrawn in light of the amendment.

B. The Objection to Claims 7, 16, and 24 Should Be Withdrawn

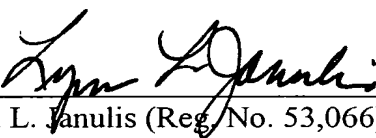
On page 3 of the Office Action, the Examiner objected to claims 7, 16, and 24 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The Applicants submit that they have canceled the base claims and amended claims 7, 16, and 24 to no longer depend on the rejected claims. Thus, the objection to dependent claims 7, 16, and 24 should be properly withdrawn.

CONCLUSION

In view of the amendment and remarks made herein, all outstanding rejections are moot and the Applicants believe that claims 7, 16, and 24 are in condition for allowance and request notification of the same.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN

By 
Lynn L. Janulis (Reg. No. 53,066)
6300 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606-6402
(312) 474-6300

April 12, 2004